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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,415	10/20/2000	Kia Silverbrook	NPA011US	1266

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BALMAIN, 2041
AUSTRALIA

EXAMINER

PHAM, THIERRY L

ART UNIT PAPER NUMBER

2624

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/693,415

Applicant(s)

SILVERBROOK ET AL.

Examiner

Thierry L Pham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6-11,14 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6-11,14 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

- This action is responsive to the following communication: an Amendment filed on 8/10/04.
- Declaration/Oath filed on 9/5/04 have been received and acknowledged.
- Amendment to the specification filed on 8/10/04 & 8/11/04 have been received and acknowledged.
- CFR filed on 9/5/04 have been received and acknowledged.
- Applicants have canceled claims 4-5, 12-13 and have been withdrawn from consideration.
- Claims 1-3, 6-11, 14-15 are still pending.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1 & 9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In addition, the specification does not provide any adequate written description of "simultaneously printing". The specification does provide "the printer is arranged to print the coded data at the same time as printing the document on the surface defining structure" (p. 4, lines 22-25). Please see response to arguments below for more details.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1, 3, 6, 8-9, 11, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Markowitz (U.S. 5513254), and in view of Dymetran et al (U.S. 6330976), and further in view of Ueno et al (U.S. 5395173).

Regarding claims 1 & 9, Markowitz discloses a method of producing (producing a document via a fax machine, fig. 2) a document by formatting user requested information (based on profile, fig. 3, col. 5, lines 49-60) in the document so as to include one user interactive element, to allow the user to effect a response to the information, including:

- (1) identifying an advertising space (identifying an available white space, fig. 4, abstract, col. 4, lines 45-57), outside an area (i.e. below the text/graphic area, fig. 4c) of the document to be occupied by the information; and
- (2) printing (printing via a fax machine, fig. 1) the document with advertising material in the space (fig. 4);
- (3) producing (fax machine, fig. 1) the document by printing information onto a surface, printing advertisement material in the advertising space (advertisement in white/available space, fig. 4).

However, Markowitz does not explicitly teach a sensing device for transmitting response back to a computer system; and simultaneously printing coded data for sensing by sensing device, said coded data being indicative of an identity of the document and of the at least one interactive element.

Dymetman, in the same field of endeavor for printing, teaches a document (figs. 14-15) so as to include one user interactive element (action/medium identifier, col. 3, lines 60-67 to col. 4, lines 1-45) and using a sensing device (pointer device 502, figs. 1-2 and figs. 8, 14-15) for

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transmitting response back to the computer system (network computer, fig. 9), and coded data being indicative of an identity of the document and of the at least one interactive element (coded data for identifying electronic document, fig. 14-15).

However, the combinations of Markowitz and Dymetman do not teach simultaneously printing coded data for sensing by sensing device, said coded data being indicative of an identity of the document and of the at least one interactive element.

Ueno, in the same field of endeavor for printing coded data, teaches simultaneously printing coded data (simultaneously printing bar code data and document data on a page, fig. 17, abstract and col. 7, lines 54-60) for sensing by sensing device (barcode reader, col. 1, lines 30-31).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Markowitz and Dymetman as per teaching of Ueno because of a following reason: (1) a sensing device for sensing invisible coded data incorporated within the document (Dymetman, col. 12, lines 65-67); (2) printing an advertisement on an available white space of the document preventing an overlap between an advertisement and the document (3) reduce hardware costs and time by printing both coded data and document data simultaneously.

Therefore, it would have been obvious to combine Markowitz, Dymetman, and Ueno to obtain the invention as specified in claims 1 & 9.

Regarding claims 3 & 11, Markowitz further discloses a method as claimed in claim 1 wherein the information is formatted at a publication server (fax server, fig. 3, col. 6, lines 1-54) of the computer system and the method includes the publication server monitoring the said area and, once the space is identified, receiving the advertising material from an advertising server (selecting advertisement from database, fig. 2, col. 6, lines 54), for including in the document.

Regarding claims 6 & 14, Dymetman further teaches a method as claimed in claim 5, which includes printing the coded data to be substantially invisible (col. 11, lines 45-50 and col. 12, lines 60-67) in the visible spectrum.

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Regarding claim 8, Dymetman further teaches a method as claimed in claim 1, wherein the sensing device (reference 502, fig. 1-2, fig. 8) includes an identification code (network address, fig. 8, col. 9, lines 24-45) specific to a particular user and the method includes monitoring (server, col. 5, lines 10-36) of the sensing device in the computer system.

2. Claims 2, 7, 10, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Markowitz, Dymetman, Ueno as applied to claims 1 and/or 9 above, and further in view of Reiter (U.S. 6178411).

Regarding claims 2 & 10, the combinations of Markowitz and Dymetman do not explicitly teach a method wherein the advertising space is determined to be on a reverse side of the document relative to the user requested information.

Reiter, in the same field of endeavor for advertising distribution, teaches a method wherein the advertising space is determined to be on a reverse side of the document relative to the user requested information (col. 2, lines 42-57 and col. 11, lines 1-4).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Markowitz, Dymetman, Ueno as per teachings of Reiter because of a following reason: (1) printing advertisements/coupons on the back/reverse side of the document provides another option/way of distributing ads; therefore, increasing ads distribution flexibilities.

Therefore, it would have been obvious to combine Markowitz, Dymetman, Ueno with Reiter to obtain the invention as specified in claims 2 & 10.

Regarding claims 7 & 15, Reiter further teaches retaining a retrievable record of the printed document (print report, col. 5, lines 50-67).

Response to Arguments

3. Applicant's arguments filed 8/10/04 have been fully considered but they are not persuasive.

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Regarding claims 1 & 9, the applicants argued the cited prior art (Dymetman) does not teach coded data and document to be printed simultaneously at the same time. The applicants have canceled claims 4-5 and incorporated its limitations into currently amended claim 1. However, previously cited claim 5 does not coincide with currently amended claim 1. For example, previously cited claim 5 states "the document is printed on a surface defining structure at the same time as the coded data is printed on the surface" wherein the currently amended claim 1 states "producing the document by printing the information onto a surface printing advertisement material in the advertising space, and 'simultaneously printing' coded data for sensing by sensing device, said coded data being indicative of an identity of the document and of the at least one interactive element". Apparently, these cited limitations do not coincide with each other. No wherein in previously claim 1 indicates document data and coded data "simultaneously printed" at the same time. In addition, the specification does not provide any adequate written description of how a "simultaneously printing" is being performed. The specification does provide "the printer is arranged to print the coded data at the same time as printing the document on the surface defining structure" (p. 4, lines 22-25). This is unclear whether document data and coded data are being printed simultaneously by two different printheads or document data and coded data are being printed "at the same time" using a single printhead. As shown in figs. 14-15 by Dymetman, a physical page (document) containing both document data and coded data. Obviously, these data are printed at the "same time". For example, an operator is submitting a print job (document data along with coded data) to be printed by a printer; a document data is printed first, following by the coded data and/or vice-versa. These operations are performed at the "same time".

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- U.S. 6072871 to Ur, teaches a printing system for printing coded data and document data simultaneously.

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5. Any rejections from previous action not addressed below have been withdrawn.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

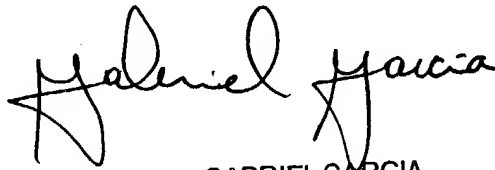
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L Pham whose telephone number is (703) 305-1897. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K Moore can be reached on (703)308-7452. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham



GABRIEL GARCIA
PRIMARY EXAMINER